



207275.0499

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Eshan B. Yeh, et al.

Serial No.: 09/922,879

Filed: August 6, 2001

For: Method For Charge-Modified Polyester

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

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) Examiner: Kirsten C. Jolley
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) Group Art Unit: 1762
)
) Confirmation No.: 9057

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RESPONSE TO RESTRICTION REQUIREMENT

Sir:

In response to the Office Action mailed August 4, 2003 setting forth a restriction requirement and an election requirement, please enter the following remarks:

REMARKS

Claims 1-28 are pending in the present application and are subject to a restriction requirement and an election requirement. In particular, the Examiner has indicated that the application contains claims directed to the following inventions:

- I. Claims 1-9 and 11-29 (the Examiner must have meant 1-9 and 11-28), drawn to a process for preparing a charge-modified polyester substrate, classified in class 427, subclass 299.
- II. Claim 10, drawn to a process for removing anionic materials from a liquid, classified in class 210, subclass 660.

In the outstanding Office Action, the Examiner explained that the inventions are distinct from each other because of the following reasons. The Examiner found that Invention I is directed to a process for preparing a charge-modified polyester substrate, while Invention II is directed to a process for removing anionic materials from a liquid. As a result, the Examiner concluded that Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the Examiner found that Inventions I and II have different modes of operation and different functions. Thus, because these inventions were found to be distinct for the reasons given above and having acquired a separate status in the art, as shown by their different classification (e.g., search required for Group II is not required for Group I), restriction for examination purposes was determined to be proper by the Examiner.

In the outstanding Office Action, the Examiner also indicated that the present application contains claims directed to the following patentably distinct species of the claimed invention:

- Species 1: treating with an alkaline agent, an amine agent, or both an alkaline agent and amine agent;
- Species 2: epoxy groups associated with a fixed negative charge or fixed positive charge; and
- Species 3: exposing to an agent prior to exposing to charge modifier, or exposing to an agent concurrently with exposing to charge modifier.

The Examiner has indicated that claims 16, 21 and 25-28 are generic and has required an election of a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

In response to the pending Restriction Requirement, Applicants hereby elect the invention of Group I defined by claims 1-9 and 11-28. Applicants reserve the right to elect and prosecute the non-elected claim in a co-pending application to be filed at a later date.


The Examiner further has required that Applicants elect a single species among Species 1-3, as defined above. Applicants hereby provisionally elect the claims directed to Species 3, i.e., exposing the substrate to an agent prior to exposing it to charge modifier or exposing the substrate to an agent concurrently with exposing it to charge modifier, if no generic claim is finally held to be allowable.

Applicants respectfully submit that claims 2, 3, 5, 6, 8, 9, 14, 15, 23 and 24 are readable on the elected species. Claims 1, 4, 7, 12, 13, 16, 21 and 25-28 are considered by the Applicants to be generic to the elected and non-elected species. In the event that no generic claim is finally held to be allowable and the present provisional election of species takes effect, the applicants hereby reserve the right to elect and prosecute the claims directed to non-elected species in one or more co-pending applications to be filed at a later date.

Based upon the foregoing, early and favorable consideration of claims 1-9 and 11-28 is respectfully requested.

Respectfully submitted,

Date: September 2, 2003

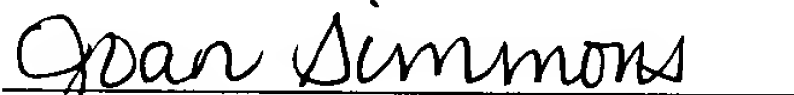

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CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

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